

REMARKS

In the Final Office Action,¹ the Examiner provisionally rejected claims 1-13, 15, and 17-46 on the ground of non-statutory obviousness-type double patenting; rejected claims 8, 23, and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1-13, 15, and 17-38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,548,750 to Larsson et al. ("*Larsson*") in view of U.S. Patent No. 6,269,382 to Cabrera et al. ("*Cabrera*"); and rejected claims 39-46 under 35 U.S.C. § 103(a) as being unpatentable over *Larsson* in view of *Cabrera* and U.S. Patent No. 6,269,382 to Chan ("*Chan*").

Applicants propose to amend claims 8, 23, and 35. Claims 1-13, 15, and 17-46 are pending.

I. Provisional Non-Statutory Obviousness-Type Double Patenting Rejections

Applicants respectfully traverse the provisional non-statutory obviousness-type double patenting rejections of claims 1-13, 15, and 17-46 over copending U.S. Application Nos. 10/526,504 and 10/526,747, and request that the provisional rejections be held in abeyance. To the knowledge of the undersigned, U.S. Application Nos. 10/526,504 and 10/526,747 are currently pending, and, thus, no double patenting circumstances can arise until a patent is granted. Since a patent has not yet issued from U.S. Application Nos. 10/526,504 and 10/526,747, Applicants respectfully request

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

that the provisional rejections be held in abeyance and any resolution in the form of a terminal disclaimer or otherwise be deferred.

II. Rejection of Claims 8, 23, and 35 Under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejection of claims 8, 23, and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asks, “[s]ince the ID for the data object will be stored in one of the transactional type lock object and the permanent type lock object, do[es] this mean[] that the data object will never be stored in the second storage location?” Final Office Action at 4. The Examiner further states that “claim 8 does not specif[y] when [the checking step] is executed.” Final Office Action at 13. Applicants respectfully submit that the “checking” step occurs before storing the ID in the transactional type lock object or the permanent type lock object. Applicants have amended claims 8, 23, and 35 accordingly. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 8, 23, and 35 under 35 U.S.C. § 112, second paragraph.

III. Rejection of Claims 1-13, 15, and 17-38 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-13, 15, and 17-38 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142(III), 8th Ed., Rev. 6 (Sept. 2007). “[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:

- (A) [Determining the scope and content of the prior art;]
- (B) Ascertaining the differences between the claimed invention and the prior art;
- and
- (C) Resolving the level of ordinary skill in the pertinent art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites a method for moving data objects comprising, for example, “storing the ID in a first lock object, thereby indicating that the data object is stored at the first storage location” and “deleting the ID from the first lock object, thereby indicating that the data object is not stored at the first storage location.”

In the Final Office Action, the Examiner alleges that *Larsson* and *Cabrera* disclose the claimed “indicati[ons] that the data object is [or is not] stored at the first storage location.” However, *Larsson* and *Cabrera* do not make such indications by “storing the ID in a first lock object” and “deleting the ID from the first lock object,” as recited in claim 1. In other words, neither *Larsson* nor *Cabrera*, nor their combination, teaches or suggests that storing and deleting an ID from a lock object respectively indicate whether a data object is or is not stored at a storage location.

For example, the Examiner alleges that, in *Larsson*, selecting a data object from a storage location indicates that the data object is stored at the storage location. Final Office Action at 5. However, claim 1 recites “storing the ID in a first lock object . . . indicat[es] that the data object is stored at the first storage location.” Selecting a data object in *Larsson* cannot correspond to “storing the ID in a first lock object,” as recited in

claim 1. Therefore, the means by which *Larsson* indicates that the data object is stored at the first storage location is not the same as that claimed. Accordingly, *Larsson* fails to teach or suggest “storing the ID in a first lock object, thereby indicating that the data object is stored at the first storage location,” as recited in claim 1.

Furthermore, even if selecting the data object in *Larsson* could correspond to the claimed “storing the ID in a first lock object,” as the Examiner alleges, *Larsson* fails to disclose that deselecting the data object from the storage location indicates that the data object is not stored in the first storage location. Accordingly, *Larsson* fails to teach or suggest “deleting the ID from the first lock object, thereby indicating that the data object is not stored at the first storage location,” as recited in claim 1.

Moreover, the Examiner alleges that “the backup handler [of *Larsson*] indicates the data object is stored in first storage location.” Final Office Action at 5. *Larsson* discloses that “backup handler instructs the local data base handlers to set a backup flag . . . , which informs the local data base handlers that backup will be started.” *Larsson*, col. 2, lines 57-60. “[T]he central backup handlers instruct all local backup handlers . . . to begin copying objects to be included in the backup to the backup area.” *Id.*, col. 3, lines 44-48. However, *Larsson* fails to disclose or suggest that the backup handlers indicate whether the data object is stored in the first storage location, and the Examiner fails to cite to any portion of *Larsson* for such a disclosure.

Cabrera fails to cure the deficiencies of *Larsson*. *Cabrera* discloses that the “[s]tep . . . of recording the migration can be accomplished in any manner sufficient to indicate . . . that the data has now been fully migrated to remote storage.” *Cabrera*, col. 11, line 67 to col. 12, line 3 (emphasis added). However, *Cabrera* fails to disclose

that “storing the ID in a first lock object and “deleting the ID from the first lock object” respectively indicate whether the data has or has not been fully migrated. *Cabrera* merely states “any manner” but fails to disclose the same manner of indication as claimed. Therefore, *Cabrera* fails to teach or suggest “storing the ID in a first lock object” and “deleting the ID from the first lock object,” as recited in claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 1 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

Furthermore, independent claims 13, 15, and 28, although different in scope from claim 1, are allowable for at least reasons similar to those given for claim 1. Additionally, dependent claims 2-12, 17-27, and 29-38 are allowable at least due to their dependence from allowable base claims 1, 15, or 28. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-13, 15, and 17-38 under 35 U.S.C. § 103(a).

IV. Rejection of Claims 39-46 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 39-46 under 35 U.S.C. § 103(a) as being unpatentable over *Larsson* in view of *Cabrera* and *Chan*. A *prima facie* case of obviousness has not been established.

Claims 39-46 depend from respective independent claims 1, 13, 15, and 28, and thus require all the elements thereof. As established above, *Larsson* and *Cabrera* fail to render obvious claims 1, 13, 15, and 28. Regardless of whether the Examiner's characterization of *Chan* in the Final Office Action is correct, *Chan* fails to cure the above-noted deficiencies of *Larsson* and *Cabrera*. Therefore, *Larsson*, *Cabrera*, and *Chan*, individually or in combination, fail to establish a *prima facie* case of obviousness with respect to claims 39-46. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 39-46 under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-13, 15, and 17-46 in condition for allowance. Applicants submit that the proposed amendments of claims 8, 23, and 35 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Applicants further submit that the entry of the amendments would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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